PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) 037145-1101	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] On July 20, 2009 Signature Typed or printed name: Kelly Allerston	Application Number 10/767,479	Filed 1/28/2004
	First Named Inventor Mikko K. Makela	
	Art Unit 2178	Examiner TERMANINI, Samir

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
   Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
   See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record.
   Registration number   37,268

☐ attorney or agent acting under 37 CFR 1.34.
   Registration number if acting under 37 CFR 1.34

/G. Peter Albert, Jr./
Signature

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Telephone Number

July 20, 2009
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Mikko K. Makela

Title: User Input System and Method for
               Selecting a File

Appl. No.:   10/767,479

Filing Date: 1/28/2004

Examiner: TERMANINI, Samir

Art Unit: 2178

Confirmation   5071
Number:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the New **Pre-Appeal Brief Conference Pilot Program**, announced July 11, 2005, this Pre-Appeal Brief Request is being filed together with a Notice of Appeal.

REMARKS

Claims 1-48 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent Publication No. 2002/0041291 to Vale (hereinafter "Vale"). Applicant respectfully traverses the rejection for at least the following reasons.

In accordance with embodiments of the present invention, a determination is made, in response to the opening of a file list by a user, as to whether there was a file previously selected by the user from the file list before the opening of the file list. If a file was previously selected by the user from the file list before the opening of the file list, then an automatic determination is

made as to whether there is a "next file" listed in relation to the previously selected file and, if so, this next file is automatically highlighted for the user.

As noted in previous responses, Applicant respectfully disagrees with the Examiner's interpretation of the disclosure of Vale as applied to the pending claims. Specifically, Applicant respectfully disagrees with the Examiner's assertion that Vale discloses certain features recited in the pending claims.

"Determining if there was a file previously selected by the user from the file list before the opening of the file list."

The Examiner alleges that Vale discloses "determining if there was a file previously selected by the user from the file list before the opening of the file list." Applicant respectfully disagrees.

Vale describes a system and method for browsing content using a particular navigation mode, with the navigation mode explicitly involving the use of a direction key by the user. It is only in response to an actuation of this direction key that a determination of whether there is a "next" file exists is made. This point is made clearly, for example, in paragraph [0010] of Vale, where it is stated:

> In navigation mode, pressing a direction key selects the next interactive element in the direction indicated by the direction key (e.g., up, down, left, right). When moving horizontally, an interactive element is in the direction indicated by the direction control if the interactive element is at substantially the same vertical level. For example, if a later element overlaps a previous element on a given vertical level by any amount, the two elements are considered to be at substantially the same vertical level. Vertical movement is to an interactive element at the next vertical level in the direction indicated by the direction control. If multiple interactive elements lie at the next vertical level, the one closest in the horizontal direction to the beginning of the current interactive element is selected. (emphasis added).

This feature is also described at paragraph [0040] of Vale, where it is explicitly noted that the operation of the navigation mode involves the receipt of a direction input 320. Continuing to

paragraph [0041], it is noted that the selection of the next interactive element (and therefore the determination of the next interactive element" is dependent upon the direction of the direction input 320, e.g., how the four-direction and action key 210 is manipulated. In each case, however, there is no discussion of this "previously selected" interactive element having been selected <u>before</u> the list of interactive elements was opened.

Vale fails to teach or suggest any determinations based on what occurred <u>before</u> a particular file list was opened, as recited in the pending claims. Vale merely discloses various processes which may occur after a navigation or edit mode has been entered into (i.e., after a file list has already been opened). For example, paragraphs [0040] and [0041] discuss how individual files may be selected based upon the use of a direction input when navigating through a list, inherently requiring that the list already be open when the direction input is actuated. Other sections of Vale also reference processes that occur after a list has been opened. In none of these locations, however, is there any discussion of making any determinations based upon what occurred <u>before</u> a list was opened.

The Examiner cites Vale as allegedly disclosing this feature at paragraph [0049]. In particular, the Examiner quotes specific text from this paragraph:

> Depending on the selected interactive element, input received
> while in edit mode may be used by the interactive element (e.g.,
> entering characters into a textbox) or may cause a return to
> navigation mode (e.g., so that another interactive element may be
> selected).

However, the cited portion of Vale fails to teach or suggest "determining if there was a file previously selected by the user from the file list before the opening of the file list." Instead, this portion of Vale only notes that a navigation mode may be entered in response to an input. Even if, for argument's sake, the entering of the navigation mode is equivalent to the opening of a file list, the above section still makes no mention of, once in navigation mode, whether a determination about whether a file was previously selected before the list was opened. This is particularly true when the immediately preceding limitation of the pending claims is considered,

namely the phrase "in response to an opening of a file list by the user." In other words, in order to meet this limitation in the pending independent claims, a determination of whether a file was selected before the file list was opened must occur after the opening of the file list. However, with no discussion of this determination being made after the navigation mode has been entered into, the entirety of this limitation cannot be met by paragraph [0049] of Vale.

In the "Response to Arguments" section of the pending Office Action, the Examiner now cites to Vale as disclosing the above-noted feature at paragraph [0041]. See Office Action dated March 19, 2009, pages 8-9. Specifically, the Examiner cites the following language from Vale:

> Returning to decision block 330, if an interactive element is visible
> in the direction of direction input 320, selecting the next
> interactive element depends on the direction of direction input 320,
> unless no interactive element <u>has been selected previously</u>.

Applicant respectfully notes that, when read in context of the disclosure of Vale, it is abundantly clear that Vale, in fact, fails to teach or suggest the above-noted feature of the pending claims. Specifically, the above-cited portion of Vale is a part of Vale's description of Figure 3 of Vale. Figure 3 illustrates "a flow diagram that corresponds to receiving a direction input <u>while navigating</u> between interactive elements." Vale, paragraph [0018] (emphasis added).

Upon entry into a navigation mode at block 310, Vale discloses that a direction input is received at block 320. See Vale, paragraph [0040]. Any selection is made after a direction input is received. There is no teaching or suggestion anywhere of any activity, let alone a selection, prior to entry into navigation mode.

This point is further illustrated by the disclosure in Vale at Figure 9A. Figure 9A of Vale illustrates the various phases of operation. In accordance with the disclosure of Figure 9A of Vale, the "Determine" step 930a includes entry into navigation mode 932, receipt of direction input 934a, and selection of an interactive element 938a. The "Determine" step 930a is preceded by the "Present" 910 and "Control" 920a steps. Neither the "Present" step 910 nor the "Control"

step 920a include any selection. The only selection disclosed in Vale occurs during the "Determine" 930a step.

Therefore, Vale fails to teach or suggest "determining if there was a file previously selected by the user from the file list before the opening of the file list," as recited in the pending claims.

Similarly, Vale fails to teach or suggest various other features of the pending claims. As noted above, Vale fails to teach or suggest "a file previously selected … before the opening of the file list." Therefore, Vale also fails to teach or suggest "if it is determined that there was a file previously selected by the user from the file list before the opening of the file list" and "automatically determining if there is a next file listed relative to the previously selected file in the file list."

Therefore, independent claims 1, 20, 30 and 40 are patentable. As to claims 2-19, 21-29, 31-39 and 41-48, these claims each depend from one of allowable claims 1, 20, 30 or 40 and are, therefore, patentable for at least the following reasons, as well as for additional patentable features when those claims are considered as a whole.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance.

Respectfully submitted,

Date: _20 July 2009_____   By ____/G. Peter Albert, Jr./_____

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